

REMARKS

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Claims 1-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Van der Gracht et al. (U.S. Patent No. 5,546,198).

Applicants traverse the rejection and request reconsideration.

Claim Rejections under 35 U.S.C. § 103

The present invention overcomes problem by providing graphic spectacles comprising a hologram mounted on spectacle frames in such a proper direction as to easily make out the top and bottom and the two sides of the hologram. Specifically, a predetermined peripheral site does not contain at least one of the phase information and amplitude information.

All the claims have been rejected based on Van der Gracht. This reference has been cited extensively in the Specification by the Applicants. The Examiner admits that Gracht does not disclose that at least one of phase information and amplitude information recorded in the peripheral site is removed. However, the Examiner contends that the removal of pixels in a predetermined peripheral site, when the function of the device is unaffected, does not serve as a basis of patentability.

The claims are amended to clarify the structure more clearly. Further, the Applicants respectfully submit that the claims recite a combination of structural features that should be given patentable weight. The Examiner is incorrect in contending that the functionality is not affected.

The Specification clearly notes a problem in the conventional devices where because of incorrect positioning of the holograms, the images are rendered upside down or symmetrical compared to the intended rendering of these images. The combination of structural features recited overcomes this problem.

The Examiner is believed to be incorrectly citing *In re Karlson* (136 USPQ 184). Arguably, *In re Karlson* holds the proposition that an omission of an element and its function in a combination where the remaining elements perform the same function as before involves only routine skills. However, this holding is not believed to be relevant in the present case for several reasons.

In the present invention, no element is “omitted” from a conventional device. In the present invention, a novel and non-obvious combination of features are included. Further, it is incorrect to contend that the same functions are performed as in conventional devices. In the present invention, because of the combination of features, a possible serious error is completely avoided. Avoidance of an error is a new function that the new combination of features additionally provide.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Amendment under 37 C.F.R. § 1.111
U.S. Application No.: 10/632,828

Attorney Docket No.: Q76817

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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